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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,517	07/09/2001	J. Jeffrey Seilhamer	219002025213	7422
25225	7590	04/02/2004	EXAMINER	
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332			EPPS FORD, JANET L	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,517

Applicant(s)

SEILHAMER ET AL.

Examiner

Janet L. Epps-Ford, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see the paper filed 1-20-04, with respect to the rejection(s) of claim(s) 32 and 42-44 under 35 USC § 102(e), and the rejection of claim 32 under 35 USC § 102(a), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Applicant's amendment, and in view of 35 USC § 112, 1st paragraph.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 32, and 42-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (Written Description and New Matter).

First it is noted that Applicants have recently added new claims 45-49. Claim 45, and those claims dependent therefrom, recite "[T]he antibodies of claim 32 that are specifically immunoreactive with human brain natriuretic peptide of SEQ ID NO: 49 or with the C-terminal amide thereof." However, Applicants do not point to any portion of the specification or claims, as originally filed, to provide support for this amendment. The term "specifically immunoreactive" is considered new matter.

The instant claims are drawn to “antibodies useful for immunoassays to detect a peptide which peptide comprises human brain natriuretic peptide...” However, the instant claims encompass antibodies that are useful to detect peptides that are not specifically described in the specification as filed. The specification as originally filed (see page 35, lines 23-25 and page 36, lines 3-7) generally states: “[C]ompounds of the present invention can also be used for preparing antisera for use in immunoassays employing labeled reagents, usually antibodies.....In addition, monoclonal antibodies can be prepared by methods known in the art, which antibodies can find therapeutic use, e.g., to neutralize overproduction of immunologically related compounds in vivo.” Clearly, at the time of filing of the instant invention, Applicants had not isolated any antibodies useful in immunoassays to detect a peptide which peptide comprises human brain natriuretic peptide (BNP) according to SEQ ID NO: 49. The specification clearly states that the antibodies of the invention can be prepared using the compounds of the invention. Moreover, there is no evidence that Applicants were in possession of antibodies that are “specifically immunoreactive with human BNP, as stated above, the specification indicates that “monoclonal antibodies can be prepared by methods known in the art.”

Furthermore, the instant claims encompass antibodies that are useful for immunoassays to detect a peptide that “comprises” the sequence set forth in the in claim 32, (SEQ ID NO: 49). However, Applicants have not described the full scope of peptides encompassed by the instant claims. Apart from the sequence set forth in SEQ ID NO: 49, there is no description of the structures of the full scope of peptides encompassed by the instant claims. For example, there is no indication of the length of the peptides of the invention. Since Applicants have not described

the full scope of peptides encompassed by the instant claims, it is unclear how Applicants could have described the full scope of antibodies encompassed by the instant claims.

See the January 5, 2001 (Vol. 66, No. 4, pages 1099-1111) Federal Register for the Guidelines for Examination of Patent Applications Under the 35 USC 112 ¶ 1, "Written Description" Requirement. These guidelines state: "[T]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that applicant was in possession of the claimed invention."

Additionally, MPEP § 2163 states: "The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence."

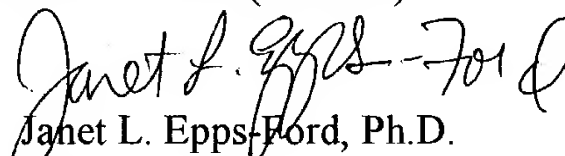
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Therefore, since it is apparent that further experimentation is required in order isolate or prepare the antibody compositions of the present invention, Applicants have not demonstrated that they were in possession of the full scope of antibodies encompassed by the instant claims at the time of filing of the instant application.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford, Ph.D. whose telephone number is 571-272-0757. The examiner can normally be reached on Monday-Saturday, Flex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Janet L. Epps-Ford, Ph.D.
Examiner
Art Unit 1635

JLE